

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested. The above listing of the claims replaces all prior versions, and listings, of claims in the application.

The rejection of claims 2-20 under 35 USC § 103 as being allegedly obvious in light of Nozaki et al., is respectfully traversed.

This rejection states that Nozaki et al. discloses a photoresist composition comprising as additives unpolymerized compounds found in column 31, lines 36 – column 33, line 5 wherein these compounds disclose structures which meet the claimed second compound of claim 2; and makes reference to compound (XLVI). The rejection then states that Nozaki et al. discloses that if the non-polymeric compounds are used and an alkali-soluble resin is added as a combination to given the required resist characteristics to the resist composition (column 32, lines 59-65).

The rejection then acknowledges that Nozaki et al. lacks the presence of the unpolymerized compound used in an explicit example in a photo resist composition, but goes on to assert that it would have been *prima facie* obvious to one of ordinary skill to use any of the compounds listed in column 31, line 36 – column 33, line 5 as a dissolution inhibitor with a base resin and an acid generator in a photoresist composition with a reasonable expectation of the same or similar results to those recited in NOZAKI et al.

However, it is submitted that claim 2 differentiates over the disclosure of NOZAKI and is non-obvious in light thereof. Merely by way of example, X in claim 2 cannot be a single COO group. That is to say, claim 2 calls for X to be $-(OCO)_m-(CH_2)_n-(COO)_m-$, where $m = 0$ or 1 and $n = 0, 1, 2$ or 3 provided when $n = 0$, $m = 0$. Thus, if these requirements are considered it will be realized that the structure shown in (XLIV) is different from that which is being claimed. Merely by way of example, when $n = 0$ and $m = 0$ there is no group *per se* and the two adamantyl groups are connected by a single bond. This possibility is neither disclosed nor suggested by Nozaki et al. When $m = 1$

and $n = 0$ then X must be $-(OCO)-(COO)-$, which again is different from a single COO group.

Newly Presented Claims

New claims 21 and 22 are presented for examination. These claims distinguish over Nozaki et al. in that claim 21 recites a specific structure for X, while new claim 22 recites specific structures for Y and Z. These arrangements are neither disclosed nor suggested by the disclosure of Nozaki et al. which fails to disclose or suggest that X is " $(CH_2)_n$ -" or that Y and Z do not include H and instead are selected from OH, F, Cl, Br or COOR. This of course renders the situation wherein Z is R and Y is H, for example, impossible.

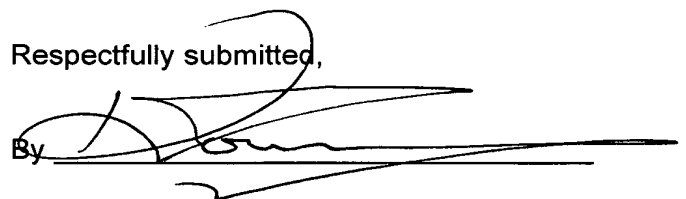
It is submitted that these new claims are patentable over the applied reference for at least the above-mentioned reasons.

Conclusion

It is respectfully submitted that the above claim amendments overcome the rejections which have been made in this Office Action. Favorable reconsideration of the rejections and allowance of this application are therefore respectfully requested. Should any outstanding issues remain, the Examiner is respectfully requested to contact the undersigned telephonically so that resolution of these matters can be expedited.

Respectfully submitted,

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